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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,197	01/31/2001	Leland James Wiesehuegel	AUS920000945US1	4475

45993	7590	11/17/2006

IBM CORPORATION (RHF)
C/O ROBERT H. FRANTZ
P. O. BOX 23324
OKLAHOMA CITY, OK 73123

EXAMINER
GARCIA, ERNESTO

ART UNIT	PAPER NUMBER
3679	

DATE MAILED: 11/17/2006

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GROUP 3600

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/773,197
Filing Date: January 31, 2001
Appellant(s): WIESEHUEGEL ET AL.

Robert H. Frantz
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 31, 2006 appealing from the Office

action mailed May 30, 2006.

· (1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

An appeal has being filed with U.S. patent application 09/714,726.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

Appellant's brief presents arguments relating to

a) objection to the disclosure and Figures 3 and 4 with respect to the terminology and naming convention of a Parts Catalog, including a database;

b) objection to the disclosure and Figures 3 and 4 with respect to the terminology and naming convention of a Sale Preparation System (SPS), including a database;

c) objection to the disclosure and Figure 3 with respect to the terminology and naming convention of an Interactive Offer Server (IOS), including a database;

d) objections to the drawings for failing to show ever feature of the invention

specified in the claims, specifically "two-computer readable repositories", an "offer

description creator", and an "offer list creator"; and,

e) objections to the specification for failing to provide proper antecedent basis for

the claimed elements, steps, or limitation of "repositories of information sets",

"computer-readable repositories of descriptive data items", "offer description creator",

and "offer list creator".

These issues relate to petitionable subject matter under 37 CFR 1.181 and not to

appealable subject matter. See MPEP § 1002 and § 1201.

(8) Evidence Relied Upon

2003/0009392	PERKOWSKI	1-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to

comply with the written description requirement. The claim(s) contains subject matter

which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 1 and 6, the original specification does not have support for the step of "dynamically linking the information sets and data items to said numbers and said manufacturer identifiers" described on claim 1, lines 7-10, and claim 6, lines 11-12.

Regarding claims 2-5, the claims depend from claim 1 and therefore do not comply with the written requirement.

Regarding claims 7-10, the claims depend from claim 6 and therefore do not comply with the written requirement.

Regarding claim 11, there is no support for "dynamic links between the descriptive data items, said parts numbers and said manufacturer identifiers" as described in lines 6-7.

Regarding claims 12-15, the claims depend from claim 11 and therefore do not comply with the written requirement.

Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1 and 6, the metes and bound of the claim is unclear. In particular, it is unclear how "executing a synchronization script or program", recited in lines 7-9, "dynamically links the information sets and data items to the part numbers and the manufacturer identifiers" recited in line 7. One skilled in the art will consider a synchronization step occurring in lines 9-10 by mere execution of the synchronization script or program; thus, it is unclear how copying information from one database to another database, which is synchronization, results dynamic linking when synchronizing information constitutes placing information of a newer database to an older database as a result both databases will have the same information. Further, it is unclear what are the "contents of a Sales Preparation System" recited in line 12.

Regarding claims 5 and 10, how does saving a copy of an information set statically links the copy to the most recently created data items?

Regarding claim 11, the metes and bounds of the claim is unclear. This claim is directed to a system yet it is unclear whether the repositories, the dynamic links, the repository synchronizer, the offer promoter, and the user interface are physical components as in electronic components. If these are mere electronic databases, the

databases need to be residing in a computer medium as in memory, or a record

medium to exist. Further, the limitation "a user interface to an Interactive Offer System

user interface" in line 14 is either grammatically incorrect, or the limitation is incomplete.

Regarding claim 12, how does adapting the repository synchronizer to replace

and add links on a timed basis further limits the system?

Regarding claim 13, how does further adapting the repository synchronizer to

replace and add links responsive to a request for information from the repositories

further limiting the system?

Claim Rejections - 35 USC § 102

Claims 1-15 are rejected under 35 U.S.C. 102(b) as being anticipated by

Perkowski, application publication, US2003/0009392 A1.

Regarding claim 1, Perkowski discloses a method comprising;

providing at least two repositories (each manufacturer has a database) of

information sets and data items indexed to product part numbers (product description

are indexed to UPN, UPC, or EAN; paragraph 023);

dynamically linking the information sets and the data items to the part numbers

and manufacturer identifiers by executing a synchronization script or program at a

predetermined time or responsive to a predetermined event (Para. 0031 and 0047-
0049; note that a program in seen running in Figure 2E4 and human interaction by
clicking on a mouse is considered "responsive to a predetermined event");

synchronizing contents of a Sales Preparation System with the repositories
(paragraph 0049; the Sales Preparation System is shown in Figure 2E1 and
synchronizes with that in Figure 2E2 to result the full set shown in Figure 2E3);

the information sets, the data items, and the contents of the Sales Preparation
System represent full information sets of most recently created data items, including the
contents of said Sales Preparation System (shown in Figure 2E3; paragraph 0049
states that the databases are updated to a master database; see also paragraph 0084
which states data-synchronized to the master UPC catalog source);

promoting the full information sets to an online auction system responsive to
authorization of a trader (Para. 0054); and

presenting the full information sets to one or more online bidders via said online
auction system (it is recognized that once the method of Perkowski is used on
online auctions; the full information sets, i.e., the synchronized contents are
presented to online bidders).

Regarding claims 2, 7, and 12, synchronizing is performed on a periodic basis
(paragraph 085).

Regarding claims 3, 8, and 13, synchronizing is performed responsive to a request. Applicants should note that the breadth of this claim does not exclude a manager of a manufacturer or someone in charge of making sure the information is uploaded to the master database. Therefore, a manager can just request an employee to synchronize the information, which in other words means synchronization is performed responsive to a request by the manager.

Regarding claims 4, 9, and 14, the method further includes:

providing a list to a user. Note, the list is viewed as a spreadsheet with text or numerical information (see paragraphs 0047,0055, 0824 and 0101).

Regarding claims 5, 10, and 15, paragraphs 0093, 0101, and 0476 indicate that the data can be statically linked which inherently indicates saving a copy of an information set linked such that the saved copy is statically linked to the most recently created data items.

Regarding claim 6, given the system of Perkowski, Perkowski discloses a computer readable medium containing a program code having the steps set forth in claim 1.

Regarding claim 11, given the method in claim 1, Perkowski discloses a system comprising:

at least two computer readable depositories of descriptive data items;

at least one of the repositories is indexed to part and manufacturer identifiers;

dynamic links between the descriptive data items and product part

numbers and the manufacturer identifiers (see Figures 2E1-2E3);

a repository synchronizer (the RDBMS; Para. 0047);

an offer promoter (CPIR; Para. 0057); and,

a user interface (CPID GUI (graphical user interface); Para. 0057).

(10) Response to Argument

112(1st) rejection

<u>Claims 1 and 6</u>

Appellants argue that the examiner's notation of no mention of "information sets"

is untrue by relying on an excerpt from the specification to prove otherwise. In

response, appellants should note that the issue whether proper antecedent basis for

"information sets" is not of concern but rather whether there is support for "dynamically

linking <u>the information sets and data items</u> to <u>said part numbers and said manufacturer</u>

<u>identifiers</u>". According to the excerpt identified, it states, "an initial set of descriptive

information dynamically linked to the part number and manufacturer identifier", which is

contrary to what the language in the claim suggests. First, it should be noted that "an

initial set of descriptive information" is formed and not "sets" as the examiner has

previously argued in last Office action. Secondly, the excerpt states that "an initial

information set dynamically links to the part number and manufacture identifier" and not both the "information sets and data items" link to the part numbers and manufacturer identifiers. It is for these reasons that the examiner is sustaining the rejection.

Claims 11-15

Appellants argue that the excerpts on page 8, lines 9-10 and page 12, lines 8-10 suggest that the description has support for dynamically linking information sets particularly to "manufacture identifiers". In response, appellants should note that this language is not what is at issue but rather whether there is support for "dynamic links between said <u>descriptive data items</u>, said <u>part numbers</u>, and said <u>manufacturer identifiers</u>". The experts relied upon by the applicant merely recite a link between the part number and the manufacture identifier only and not between three features, i.e., the descriptive data items, the part numbers and the manufacturer identifiers. Appellants then make the argument that "set of descriptive information" is referring to "descriptive information items". In response, appellants should note that the language "set of descriptive information" is not at stake, but rather what the examiner has underlined.

112(2nd) rejections

(1) With regards to the first issue, the examiner is dropping this rejection. However, it appears that the whole claim would be invalid until a trader makes a request.

(2) Appellants argue that the appellants previously replied to the rejection and the argument has been represented again in the brief. Further, appellants present arguments in reference to the step of "synchronizing contents of a Sales Preparation System" and the remaining steps following the synchronization. In response, appellants

should note that these steps are not in question but rather how the second step, in particular, "executing a synchronization scrip or program" dynamically links "the information sets and the data items to the part number and the manufacturer identifiers". Note that this is a different synchronization step than that after the conditional statement, "upon request of a trader": The examiner merely questions how synchronizing results "dynamically linking". Appellants then argue that linking and synchronization are not the same but fail to describe what is dynamic linking according to the specification.

Accordingly, it is still unclear how executing the synchronization script or program causes dynamic linking as in a hyperlink. According to the definition of "File synchronization", as provided by the appellants, no mention of linking is ever mentioned. The definition rather discusses two methods of synchronizing. Appellants then argue "an enhanced synchronization process" is being claimed, "which ensures that where data sets include links to other sources, those links are dynamically updated in all data sets to point to the same sources". In response, it should be noted that no mention of links or that the links are updated dynamically, is recited in claims 1 and 6.

(3-5) With regards to the "contents of a Sales Preparation System (SPS)", appellants make reference to a SPS database 60. In response, it should be noted that a "database" and a "system" are two different concepts, thus how can a system be a database. Furthermore, if the SP system is the database as applicants allege, then the

contents, i.e., which includes photographs 605, specifications 606, and quantities 607,

results double inclusion of the same thing because these contents are the same data

items. The examiner alleges that the contents are included twice since the specification

indicates on page 12, lines 8-10 that the data items 605, 606, and 607, in claim 1, line 4,

are also the same features of the contents of the SPS. Appellants should note that

initially these items are loaded to the SPS as recited on page 12, lines 8-10 of the

specification. The question the examiner raises is how can the contents of the SPS and

the data items synchronize. For these reasons, it is unclear what are the "contents of a

Sales Preparation System". Appellants make reference to "synchronize to the other

databases" is accurate and clear; yet, nowhere in the claims does it mention this

limitation.

(6) Appellants allege that they don't understand what "most created data items" means.

It is clear that the examiner is referring to the "most recently created data items". Note

that arguing that the examiner did not named the items accordingly, does not resolve

the issue, which is how does saving a copy of a set statically links the copy to the items

for someone skilled in the art to particularly understand.

(7) With respect to claim 11, appellants argue that the examiner has not offered in the

rationale any evidence to support a holding "of databases" being abstract "data" devoid

or separate from computer hardware, programs, or the like. In response, the examiner

has provided clear evidence that the claims are directed to "a system", i.e., something

—

physical or tangible. The claim merely recites databases without mentioning where they are resided, thus it renders the claim questionable to whether the system is structural, or just mentally construed ideas since it is unclear where the databases are residing.

(8-9) With respect to claim 12 and 13, appellants allege that these claims add limitations to the additional functionality of the system. In response, appellants should note that in article claims, i.e., the system, any structural limitation is a determining factor for determining patentability and not how the system operates or what it does. Since the claims are directed to the system, these limitations do not add any structural features of the system and thus it is unclear how they serve to determine patentability of the system.

102(e) rejection

claims 1-15

Appellants argue that Perkowski does not disclose updating links "automatically". In response, it should be noted that the rejected claims do not recite "updating links automatically" and thus the argument is not commensurate with the scope of the claims. Appellant further argue that Perkowski does not disclose "updating links within those databases". In response, it should also be noted that the rejected claims do not recite "updating links within databases" and thus the argument is also not commensurate with the scope of the claims. Appellant further argue that Perkowski teach a conventional data synchronization as provided by definition. In response, the fact that synchronization is conventional does not render the process unreadable on the claims.

Note that the claims broadly recite synchronization, which also reads on conventional techniques. If appellants believe they have invented a new type of synchronization, appellants ought to concentrate on defining the new process of synchronization in a divisional application. Appellant further argue that the method in Perkowski has links relatively static in nature until manually modified, changed or updated, or until information is copied from each database. In response, it is noted that static links are present in Perkowski; however, this does not differentiate from the scope of claim 5, which also recites "statically" in line 2 as well. So it is clear from claim 5, that the links are static as well as Perkowski's static links.

Appellants argue that by contrast to Perkowski, the links between the databases are updated in real time or on-demand. In response, it should be noted that "updating in real-time or on-demand" is nowhere recited in the rejected claims and therefore are not commensurate in scope to the rejected claims. Appellants then argue that "dynamically" means updating in real time or on-demand. In response, it should be noted that no such definition is present in the recited pages and line numbers. Appellants are trying to define or put meaning to "dynamically" when such has not been originally set forth. In regards to the language, "triggered at a predetermined time or responsive to a predetermined event", it should be established that such language is of broad scope that even human interaction by clicking on a mouse once a day is considered "a predetermined event". According to paragraph 0049 in Perkowski, it

establishes that the database is <u>continuously</u> maintained and thus it is established that the links and databases are maintained on a daily basis, i.e. "a predetermined time".

Appellants then argue that the interpretation "continuously maintained" refers to "continuously <manually> maintained" and is not continuously maintained by an automatic synchronization script which dynamically links information. In response, it should be noted again that the recitation "automatic" is nowhere found in the rejected claims. Further, appellants believe that such term has been established by the term "dynamically"; however, the examiner disagrees because such definition was not established in the specification and synchronization according to claim 1, line 11, occurs upon a request by the trader, and thus is not automatic as appellants allege.

Appellants argue that the "consumers" manually perform the steps. In response, it should be reiterated that "automatic" is nowhere found in the rejected claims and such claims are of broad scope that it tends to cover both "manual" and "automatic".

Appellants argue that paragraph [0080] in Perkowski "does not describe dynamically linking between databases in the manner the appellants have claimed. In response, the argument is out of scope since such manner of dynamically linking is not specifically argued to distinguish differences between the prior art and "the manner appellants have claimed". According to the rejected claims, the step of dynamically linking is defined by executing a synchronization script or program at a predetermined

time or response to a predetermined event, which Perkowski has done in paragraph

[0080] and confirmed by appellants as paraphrased in the last paragraph of page 23 of

the brief.

Appellants further argue that Perkowski "is actually silent as to updating dynamic

links". In response, it should be noted that "updating dynamic links" is not a step

defined in the rejected claims and such argument is not commensurate with the rejected

claims.

Appellants conclude by arguing that paragraph [0988] as argued by the examiner

is describing a manually-performed process by an "author" in which the author initiates

a "data linking mode" and creates links by "drawing graphical boundaries around the

content using a mouse-pointing device" or "drawing a graphical link between" a web

document and print-media document, etc. Appellants finalize the argument by

indicating that the operation remains manually triggered and manually specified. In

response, it should be noted that "automatic" is nowhere recited in the rejected claims

and thus the argument is not commensurate in scope with the rejected claims. Further,

it should be noted that paragraph [0991] states in lines 5-6 that the process can

"automatically generate UPN/TM/PD/URL data links tables" as part of an alternative

way of creating data links. Therefore, Perkowski clearly anticipates the steps, elements,

and the limitations of appellants' claims and those argued, i.e., having the process be

"automatic".

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the

Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Ernesto Garcia

Conferees:

Yogesh Garg
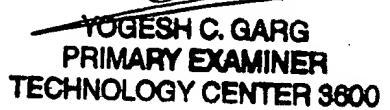
YOGESH C. GARG
PRIMARY EXAMINER
TECHNOLOGY CENTER 3600

Vincent Millin